Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES
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Ex parte RONALD S. COK and JOHN R. FREDLUND
_____

Appeal No. 1998-2680
Application 08/681,653
_____

ON BRIEF
_____

Before THOMAS, SMITH, JERRY and BLANKENSHIP, Administrative Patent Judges.

SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-15, which constitute all the claims in the application.

The disclosed invention pertains to a method for combining at least one captured generated digital image with at least one prestored digital image. More particularly, a customer generated digital image is analyzed to obtain a design attribute and/or style. A prestored digital image is then automatically selected which has a design attribute and/or style that most closely matches the customer generated image.

The customer image and the selected image are then combined to form a merged image.

Representative claim 1 is reproduced as follows:

1. A method of combining at least one captured generated digital image with at least one prestored digital image, comprising the steps of:

a) providing at least one capture means for obtaining a customer generated image in digital form;

b) analyzing said customer generated digital image so as to obtain a design attribute and/or style of said customer generated digital image;

c) comparing the obtained design attribute and/or style of the customer generated digital image with design attributes and/or style of prestored digital images;

d) automatically selecting a prestored digital image which has a design attribute and/or style that matches the obtained design attribute and/or style of the customer generated digital image;

e) combining said customer generated image and said selected prestored digital image so as to form a merged image; and

f) forwarding said merged image to an output device.

The examiner relies on the following references:

Watkins et al. (Watkins)   5,459,819   Oct. 17, 1995

The admitted prior art described in appellants' specification.

Claims 1-15 stand rejected under 35 U.S.C. § 103. As evidence of obviousness the examiner offers Watkins in view of the admitted prior art.

Rather than repeat the arguments of appellants or the examiner, we make reference

to the briefs and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced

by the examiner and the evidence of obviousness relied upon by the examiner as support

for the rejection. We have, likewise, reviewed and taken into consideration, in reaching

our decision, the appellants' arguments set forth in the briefs along with the examiner's

rationale in support of the rejection and arguments in rebuttal set forth in the examiner's

answer.

It is our view, after consideration of the record before us, that the evidence relied

upon and the level of skill in the particular art would not have suggested to one of ordinary

skill in the art the obviousness of the invention as set forth in claims 1-15. Accordingly, we

reverse.

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to

establish a factual basis to support the legal conclusion of obviousness. See In re Fine,

837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner

is expected to make the factual determinations set forth in Graham v. John Deere Co., 383

U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary

skill in the pertinent art would have been led to modify the prior art or to combine prior art

references to arrive at the claimed invention. Such reason must stem from some teaching,

suggestion or implication in the prior art as a whole or knowledge generally available to

one having ordinary skill in the art. Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044,

1051, 5 USPQ2d 1434, 1438 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988); Ashland Oil,

Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed.

Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hosp. Sys., Inc. v. Montefiore Hosp.,

732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the

examiner are an essential part of complying with the burden of presenting a prima facie

case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444

(Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome

the prima facie case with argument and/or evidence. Obviousness is then determined on

the basis of the evidence as a whole and the relative persuasiveness of the arguments.

See Id.; In re Hedges, 783 F.2d 1038, 1039, 228 USPQ 685, 686 (Fed. Cir. 1986); In re

Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart,

531 F.2d 1048, 1052, 189 USPQ 143, 147 (CCPA 1976). Only those arguments actually

made by appellants have been considered in this decision. Arguments which appellants

could have made but chose not to make in the brief have not been considered [see 37

CFR § 1.192(a)].

The examiner's rejection of the appealed claims is set forth on pages 4-10 of the

examiner's answer. In this rejection, the examiner asserts that Watkins teaches all the

steps of the claimed invention except for the step of comparing the obtained design

attribute and/or style of the customer generated digital image with the design attribute and/or style of the prestored digital images [answer, page 9]. The examiner asserts that appellants' admitted prior art in the specification shows that this limitation is directed to what one of ordinary skill in the art would have known and is not patentable [id., pages 9-10].

With respect to each of independent claims 1, 5 and 9, appellants argue that Watkins not only fails to teach the comparing step as acknowledged by the examiner, but also fails to teach the step of automatically selecting a prestored digital image as recited in those claims. Appellants also argue that the section of the specification relied on by the examiner does not constitute an admission that the claimed comparison step followed by the claimed automatic selection of a prestored digital image was known in the art [brief, pages 2-7].

The examiner disputes both of appellants' assertions that Watkins does not teach the claimed step of automatically selecting a prestored digital image and that the missing steps of the claimed invention are admitted to be prior art in appellants' specification [answer, pages 14-20].

With respect to appellants' first argument, we agree with appellants that Watkins does not teach or suggest the step of automatically selecting a prestored digital image as recited in independent claims 1, 5 and 9. The flowchart for Watkins' method is shown in Figure 2. The first step of this method is for the user or consumer to visually examine and

select a prestored image and a desired output format [step 100]. Thus, prestored images

in Watkins are manually selected by the user at the beginning of the process. This is the

only time that prestored images are selected in Watkins. Therefore, as argued by

appellants, Watkins does not teach or suggest the step of automatically selecting a

prestored digital image as recited in the appealed claims. This deficiency in the teachings

of Watkins would be sufficient by itself to require the reversal of the examiner's rejection.

We also note for the record that the examiner's assertion that appellants'

specification constitutes admitted prior art with respect to the claimed invention is

untenable. The examiner points to pages 7-8 of the specification wherein it is stated:

> The CPU 10, through use of appropriate software, can analyze
> the digital representation of image 110 to obtain a value for a
> particular style or design attribute. For example, vector
> analysis, as is well known in the art, can be used to determine
> the directionality of the image. The result of this analysis
> produces a value which is compared to the directionality
> values of various prestored digital images (previously
> obtained and stored in memory) whereby the computer will
> automatically select the prestored images having the closest
> or dominate corresponding value in accordance with
> predetermined parameters.

It is the examiner's view that the reference to "appropriate software" and well known "vector

analysis" somehow suggests that the claimed comparison is admitted to be prior art. We

do not agree.

The specification merely establishes that techniques were known to obtain a value

for a particular style or design attribute. The specification further establishes that these

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techniques could be used to derive the software necessary to implement the comparison

and automatic selecting steps of the claimed invention. Appellants are correct, however,

that this portion of the specification does not in any manner suggest that the steps of

comparing and automatically selecting, as recited in the appealed claims, were admitted

to be prior art as asserted by the examiner.

The examiner has failed to provide us with a record that supports a prima facie

case of the obviousness of the claimed invention. Therefore, the decision of the examiner

rejecting claims 1-15 is reversed.

REVERSED

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JS:yrt

cc: Leonard W. Treash, Jr.
       Eastman Kodak Company

Patent Legal Staff
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